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TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

CHOOBIN, BARRY

ART UNIT

PAPER NUMBER

2621

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/836,867

Applicant(s)

BALABAN ET AL.

Examiner

Barry Choobin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 3, 4 are objected to because of the following informalities: "the method of claim A1" should be –the method of claim 1-. Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 - 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 -14 of U.S. Patent No. 6,229,911. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application' claim merely is a broader version of the patented claims and encompasses the same scope.

As to claim 1, in instant application recites "a computer-implemented method for managing information relating to processing of polymer probe arrays, said method comprising the steps of: creating an electronically-stored experiment table, said experiment table storing a record for an experiment, said experiment record comprising: a first identifier identifying a target sample applied to a polymer probe array chip in said experiment; a second identifier identifying said polymer probe array chip to which said target sample was applied in said experiment; and creating an electronically-stored chip table, said chip table storing a record for said polymer probe array chip, said chip record comprising:

said second identifier identifying said polymer probe array chip; and a third identifier specifying a layout of polymer probes on said polymer probe array chip. "; the U.S. Patent 6,229,911, claim 1 recites, "A computer-implemented method for managing information relating to processing of polymer probe arrays, said method comprising: creating an electronically-stored experiment table, said experiment table storing a record for an experiment, said experiment record comprising a plurality of fields storing at least one of a plurality of data identifiers, including: a first identifier identifying target sample applied to a polymer probe array chip

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in said experiment; a second identifier identifying said polymer probe array chip to which said target sample was applied in said experiment; and creating an electronically-stored chip table, said chip table storing a record for said polymer probe array chip, said chip record comprising a plurality of fields storing at least one of a plurality of data identifiers, including: said second identifier identifying said polymer probe array chip, and a third identifier specifying a layout of polymer probes on said polymer probe array chip.”.

As to claim 2, instant application recites “The method of claim A1 further comprising the step of - performing an experiment wherein said target sample is applied to said polymer probe array chip.”; the U.S. Patent 6,229,911 claim 2 recites “the method of claim 1 further comprising: performing an experiment wherein said target sample is applied to said polymer probe array chip.”.

As to claim 3, instant application recites, “The method of claim A 1 further comprising the steps of -creating an electronically-stored target table, said target table storing a record for said target sample, said target sample record comprising: said first identifier identifying said target sample; and a fourth identifier specifying parameters of preparation of said target sample.”; the U.S. Patent 6,229,911 claim 3 recites “The method of claim 1 further comprising: creating an electronically-stored target table, said target table storing a record for said target sample, said target sample

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record comprising: said first identifier identifying said target sample; and a fourth identifier specifying parameters of preparation of said target sample.”.

As to claim 4, instant application recites “The method of claim A1 wherein said polymer probe array chip comprises an oligonucleotide array chip.”; the U.S. Patent 6,229,911 claim 4 recites “The method of claim 1 wherein said polymer probe array chip comprises an oligonucleotide array chip.”.

As to claim 5, instant application recites “A computer-implemented method for managing information relating to processing of oligonucleotide probe arrays, said method comprising the steps of; creating an electronically stored analysis table, said analysis table listing for each of a plurality of expression analysis operations: a first identifier specifying a particular analysis operation a second identifier specifying oligonucleotide array processing result information on which said particular expression analysis operation has been performed; and creating an electronically stored gene expression result table, said gene expression result table listing for each of selected ones of said plurality of analysis operations, a list of genes or expressed sequence tags and results of said particular expression analysis operation as applied to each of said genes or expressed sequence tags.”; the U.S. Patent 6,229,911 claim 1 recites “A computer-implemented method for managing information relating to processing of polymer probe arrays, said method comprising: creating an electronically-stored experiment table, said experiment table storing a record for an experiment, said

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experiment record comprising a plurality of fields storing at least one of a plurality of data identifiers, including: a first identifier identifying target sample applied to a polymer probe array chip in said experiment; a second identifier identifying said polymer probe array chip to which said target sample was applied in said experiment; and creating an electronically-stored chip table, said chip table storing a record for said polymer probe array chip, said chip record comprising a plurality of fields storing at least one of a plurality of data identifiers, including: said second identifier identifying said polymer probe array chip, and a third identifier specifying a layout of polymer probes on said polymer probe array chip.”.

As to claim 6, instant application recites “ A computer-implemented method for managing information relating to processing of polymer probe arrays, said method comprising the steps of: storing in an electronically-stored experiment table for each of a plurality of experiments, a first identifier identifying a target sample applied to an polymer probe array chip in a particular experiment; storing in said electronically-stored experiment table for each of said plurality of experiments a second identifier identifying said polymer probe array chip to which said target sample was applied in said particular experiment; storing in an electronically-stored chip table for each of a plurality of polymer probe array chips, said second identifier identifying a particular polymer probe array chip; and storing in said electronically-stored chip table for each of said plurality of polymer probe arrays chips a third identifier specifying a layout of polymer

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probes on said polymer probe array chip.”; the U.S. Patent 6,229,911 claim 5, recites “A computer-implemented method for managing information relating to processing of polymer probe arrays, said method comprising:

storing in an electronically-stored experiment table having a plurality of fields holding at least one of a plurality of data identifiers, for each of a plurality of experiments, a first identifier identifying a target sample applied to an polymer probe array chip in a particular experiment; storing in said electronically-stored experiment table for each of said plurality of experiments a second identifier identifying said polymer probe array chip to which said target sample was applied in said particular experiment; storing in an electronically-stored chip table having a plurality of fields holding at least one of a plurality of data identifiers, for each of a plurality of polymer probe array chips, said second identifier identifying a particular polymer probe array chip; and storing in said electronically-stored chip table for each of said plurality of polymer probe arrays chips a third identifier specifying a layout of polymer probes on said polymer probe array chip.”.

As to claim 7, instant application recites “The method of claim 6 further comprising the steps of storing in an electronically-stored target table, for each of a plurality of target samples, said first identifier identifying a particular target sample; and storing in said electronically-stored target table, for each of said plurality of target samples, a fourth identifier specifying parameters of preparation of said particular target sample.” ; the U.S. Patent 6,229,911 claim 6 recites “The method of claim 5 further



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comprising: storing in an electronically-stored target table, for each of a plurality of target samples, said first identifier identifying a particular target sample; and storing in said electronically-stored target table, for each of said plurality of target samples, a fourth identifier specifying parameters of preparation of said particular target sample.”.

As to claim 8, instant application recites “The method of claim 6 wherein said polymer probe array chip comprises an oligonucleotide array chip.”; the U.S. Patent 6,229,911 claim 7, recites “The method of claim 5 wherein said polymer probe array chip comprises an oligonucleotide array chip.”.

As to claim 9, instant application recites “A computer-readable storage medium having stored thereon: code for creating an electronically-stored experiment table, said experiment table listing for each of a plurality of experiments: a first identifier identifying a target sample applied to an oligonucleotide array chip in a particular experiment; a second identifier identifying said oligonucleotide array chip to which said target sample was applied in said particular experiment; and code for creating an electronically-stored chip table, said chip table listing for each of a plurality of oligonucleotide array chips: said second identifier identifying said particular oligonucleotide array chip; and a third identifier specifying a layout of oligonucleotide probes on said particular oligonucleotide array chip.”; the U.S. Patent 6,229,911 claim 8 recites “A computer-readable storage medium having stored thereon: code for creating an electronically-stored experiment table, said experiment table listing for each of a plurality of

experiments a plurality of fields storing at least one of a plurality of data identifiers, including:

a first identifier identifying a target sample applied to an oligonucleotide array chip in a particular experiment; a second identifier identifying said oligonucleotide array chip to which said target sample was applied in said particular experiment; and code for creating an electronically-stored chip table, said chip table listing for each of a plurality of oligonucleotide array chips a plurality of fields storing at least one of a plurality of data identifiers, including:  
said second identifier identifying said particular oligonucleotide array chip; and  
a third identifier specifying a layout of oligonucleotide probes on said particular oligonucleotide array chip.”.

As to claim 10, instant application recites “The computer-readable storage medium of claim 9 having further stored thereon: code for creating an electronically-stored target table, said target table listing records comprising:  
said first identifier identifying said target sample for one or more of said plurality of experiments; and a fourth identifier specifying parameters of preparation of said target sample for one or more of said plurality of experiments.”; the U.S. Patent 6,229,911 claim 9 recites “The computer-readable storage medium of claim 8 having further stored thereon: code for creating an electronically-stored target table, said target table listing

records comprising: said first identifier identifying said target sample for one or more of said plurality of experiments; and a fourth identifier specifying parameters of preparation of said target sample for one or more of said plurality of experiments.”.

As to claim 11, instant application recites “ A computer-readable storage medium having stored thereon: an electronically-stored experiment table, said experiment table listing for each of a plurality of experiments: a first identifier identifying a target sample applied to an oligonucleotide array chip in a particular experiment; a second identifier identifying said oligonucleotide array chip to which said target sample was applied in said particular experiment; and an electronically-stored chip table, said chip table listing for each of a plurality of oligonucleotide array chips: said second identifier identifying a particular oligonucleotide array chip; and a third identifier specifying a layout of oligonucleotide probes on said particular oligonucleotide array chip.”; the U.S. patent 6,229,911 claim 8 recites “A computer-readable storage medium having stored thereon: code for creating an electronically-stored experiment table, said experiment table listing for each of a plurality of experiments a plurality of fields storing at least one of a plurality of data identifiers, including: a first identifier identifying a target sample applied to an oligonucleotide array chip in a particular experiment; a second identifier identifying said oligonucleotide array chip to which said target sample was applied in said particular experiment; and code for creating an electronically-stored chip table, said chip table listing for each of a plurality of oligonucleotide array chips a plurality of fields storing at least one of a plurality of data

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identifiers, including: said second identifier identifying said particular oligonucleotide array chip; and a third identifier specifying a layout of oligonucleotide probes on said particular oligonucleotide array chip.”.

As to claim 12, instant application recites “ A computer-readable storage medium for managing information relating to processing of oligonucleotide arrays, said storage medium having stored thereon: code for creating an electronically stored analysis table, said analysis table listing for each of a plurality of expression analysis operations: a first identifier specifying a particular analysis operation a second identifier specifying oligonucleotide array processing result information on which said particular expression analysis operation has been performed; and code for creating an electronically stored gene expression result table, said gene expression result table listing for each of selected ones of said plurality of analysis operations, a list of genes and results of said particular expression analysis operation as applied to each of said genes.”; the U.S. Patent 6,229,911 claim 10 recites “A computer-readable storage medium having stored thereon: an electronically-stored experiment table, said experiment table listing for each of a plurality of experiments a plurality of fields storing at least one of a plurality of data identifiers, including:

a first identifier identifying a target sample applied to an oligonucleotide array chip in a particular experiment; a second identifier identifying said oligonucleotide array chip to which said target sample was applied in said particular experiment; and an electronically-stored chip table, said chip table listing for each of a plurality

of oligonucleotide array chips a plurality of fields storing at least one of a plurality of data identifiers, including: said second identifier identifying a particular oligonucleotide array chip; and a third identifier specifying a layout of oligonucleotide probes on said particular oligonucleotide array chip.”.

As to claim 13, instant application recites “A computer readable storage medium having stored thereon: an analysis table, said analysis table listing for each of a plurality of expression analysis operations: a first identifier specifying a particular analysis operation a second identifier specifying oligonucleotide array processing result information on which said particular expression analysis operation has been performed; and a gene expression result table, said gene expression result table listing for each of selected ones of said plurality of analysis operations, a list of genes and results of said particular expression analysis operation as applied to each of said genes.”; the U.S. Patent 6,229,911 claim 10 recites “ A computer-readable storage medium having stored thereon: an electronically-stored experiment table, said experiment table listing for each of a plurality of experiments a plurality of fields storing at least one of a plurality of data identifiers, including: a first identifier identifying a target sample applied to an oligonucleotide array chip in a particular experiment; a second identifier identifying said oligonucleotide array chip to which said target sample was applied in said particular experiment; and an electronically-stored chip table, said chip table listing for each of a plurality of oligonucleotide array chips a plurality of fields storing at least one of a

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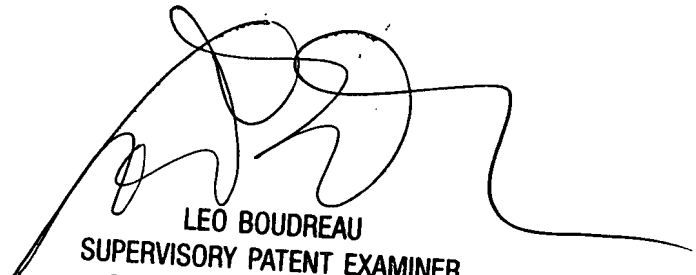
plurality of data identifiers, including: said second identifier identifying a particular oligonucleotide array chip; and a third identifier specifying a layout of oligonucleotide probes on said particular oligonucleotide array chip.”.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry Choobin whose telephone number is 703-306-5787. The examiner can normally be reached on M-F 7:30 AM to 18:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Barry Choobin  
July 12, 2002



LEO BOUDREAU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600